

HP Docket No. 10016783-1

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REMARKS

Applicants appreciate the Office's review of the present application. In response to the Office Action, the cited references have been reviewed, and the rejections and objections made to the claims by the Examiner have been considered. The claims presently on file in the present application are believed to be patentably distinguishable over the cited references, and therefore allowance of these claims is earnestly solicited.

Rejections**Rejection Under 35USC §112 First Paragraph**

Claims 2, 3, 6, 30, 32 and 33 have been rejected under 35 USC §112, paragraph 1, as failing to comply with the enablement requirement. The Office alleges that these claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In addition, these claims have also been rejected under 35 USC §112, paragraph 1, as failing to disclose the best mode contemplated by the inventor.

Applicants believe that the subject matter at issue is adequately described, and the best mode disclosed, at page 8, line 7 – page 9, line 19 with regard to claims 2, 3, 6, and 30; and at page 5, line 24 – page 6, line 8 with regard to claims 32 and 33. However, to expedite prosecution, the specification has been amended to add a new paragraph that describes the subject matter of these claims. Support for the amendment is provided by claims 2, 3, 6, 30, 32, and 33 as originally filed.

In view of the foregoing, it is submitted that the rejections under 35 USC §112, paragraph 1, have been overcome and should be withdrawn.

Rejection Under 35USC §102

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Claims 2-4, 6, 15, 17-18, 21-24, and 30 have been rejected under 35 USC §102(c), as being anticipated by U.S. patent application publication 2002/0032652 to Aoki et al. ("Aoki"). Applicants respectfully traverse the rejection and request reconsideration based on features in the claims which are neither disclosed nor suggested in the cited reference.

As to a rejection under §102, "[a]nticipation is established only when a single prior art reference discloses expressly or under the principles of inherence, each and every element of the claimed invention." *RCA Corp. v. Applied Digital Data Systems, Inc.*, (1984, CAFC) 221 U.S.P.Q. 385. The standard for lack of novelty, that is for "anticipation," is one of strict identity. To anticipate a claim, a patent or a single prior art reference must contain all of the essential elements of the particular claims. *Schroeder v. Owens-Corning Fiberglass Corp.*, 514 F.2d 901, 185 U.S.P.Q. 723 (9th Cir. 1975); and *Cool-Fin Elecs. Corp. v. International Elec. Research Corp.*, 491 F.2d 660, 180 U.S.P.Q. 481 (9th Cir. 1974). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

The rejection of independent claim 3 is respectfully traversed at least because the single cited reference does not disclose all of the essential elements of the claims arranged as required by the claims and in as complete detail as in the claims. In this regard, claim 3 recites:

"3. (Previously presented) A print by reference method executable by a portable wireless device, the method comprising the steps of:
obtaining a reference to print content stored at a location indicated by the reference; and
wirelessly communicating the reference to another device to initiate a print by reference of the print content,
wherein the reference specifies print format information." (emphasis added)

Applicants respectfully believe that this rejection is inadequate to establish a prima facie case of anticipation because the single cited reference does not disclose all of the essential elements of the claims arranged as required by the claims and in as complete detail as in the

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claims.

With regard to the limitation of “wirelessly communicating the reference to another device to initiate a print by reference of the print content”, the Office states that these features are disclosed by Figs. 1 and 2 of the Aoki reference. Applicants respectfully disagree.

Fig. 1 is a schematic diagram showing the constructions of data output control apparatuses, while Fig. 2 is a block diagram showing the construction of a network system in which a data output control apparatus is applied. With regard to features illustrated in Fig. 2, the Aoki reference discloses that:

“A data output control terminal 300 is communicatively connected via the Internet 400 to a portable terminal 100 carried by a user, printing apparatuses PR1 to PRn provided at various locations, and WWW servers DS1 to DSm. The data output control terminal 300 obtains from a WWW server DS data associated with a data print request from the portable terminal 100, selects one of the plurality of printing apparatuses PR, and outputs the obtained data to the selected printing apparatus.” (Abstract)

Processing of the data print request is described further with reference to the flowchart of Fig. 4.:

“The processes then move to step S104, in which various information associated with printing is input via the key panel 40. As the various information associated with printing, the user inputs, for example, a URL which uniquely identifies the location of the WWW server DS on the Internet, which stores the print data to be printed, a desired service area which is the approximate location where the service of output data is desired, print specifications of the printing apparatus PR, such as the size of paper, a designation of color/monochrome, printing resolution, and printing speed, a data format of the print data to be printed, and when a printing apparatus PR is to be directly specified, a printing apparatus ID for identifying the printing apparatus PR. All of these input items are not necessarily required, but are selectively input according to user requirements. ... Next, the processes move to step S108, in which the data print request is transmitted to the data output control terminal 300.” (para. [0078]-[0080]; emphasis added).

Thus, steps S104 and S108 wirelessly communicate the reference (i.e. the URL) from the wireless device (i.e., portable terminal 100) to another device (i.e., data output control terminal 300). However, wirelessly communicating the reference does not initiate a print by reference of the print content, as required by Applicants’ claim 2. A print by reference of the print content

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may be initiated only by a subsequent user input after wirelessly communicating the reference, and printing may not even be performed depending on the input the user provides.

Instead, a number of different operations, beginning at step S110 in Fig. 4, are performed according to the Aoki reference. At S120, "preview data is received from the data output control terminal 300, and based on the received preview data, an image of a print by the determined printing apparatus PR is displayed on the LCD 44" of portable terminal 100 (para. [0083]). Subsequently,

"In step S122, it is determined whether or not the print data to be printed is actually the image displayed on the LCD 44. If it is determined that the image displayed on the LCD 44 is correct (Yes) by an input via the key panel 40 which selects that the image displayed on the LCD 44 is correct, the processes move to step S124. ... In step S124, a data print execution request is transmitted to the data output control terminal 300. ... On the other hand, if it is determined that the image displayed on the LCD 44 is wrong (No) according to an input via the key panel 40 which selects that the image displayed on the LCD 44 is wrong, the processes move to step S132, in which a halt signal, which is a request for halting the data print, is transmitted to the data output control terminal 300. The series of processes is then exited." (para. [0084]-[0086]).

Thus, initiating a print by reference of the print content occurs not as a result of wirelessly communicating the reference, but rather if, and only if, the user provides a subsequent user input to the portable terminal 100 indicating that the preview image is correct. If the user indicates that the preview image is wrong, no printing is performed, even though the reference has previously been wirelessly communicated from the portable terminal 100 to the data output control terminal 300.

The novel features of the present invention are not anticipated by the Aoki reference in that the essential element of wirelessly communicating the reference to another device to initiate a print by reference of the print content, arranged as required by the claim and recited in as complete detail as in the claim, is absent from the reference. Therefore, the rejection is improper at least for that reason and should be withdrawn.

Independent claims 4, 17, 21, and 30 each recite limitations similar to those of claim 3,

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discussed above. For similar reasons as explained heretofore with regard to claim 3, the novel features of the present invention are not anticipated by the Aoki reference in that at least one essential element, arranged as required by the claims and in as complete detail as in the claims, is absent from the reference. Therefore, the rejection of these independent claims, and their corresponding dependent claims 18 and 22-24 is improper at least for this reason and should be withdrawn.

The rejection of independent claim 2 is respectfully traversed at least because the single cited reference does not disclose all of the essential elements of the claims arranged as required by the claims and in as complete detail as in the claims. In this regard, claim 2 recites:

“2. (Previously presented) A print by reference method executable by a portable wireless device, the method comprising the steps of:

obtaining a reference to print content stored at a location indicated by the reference; and
wirelessly communicating the reference to another device to initiate a print by reference of the print content,

wherein the reference specifies billing information.” (emphasis added)

Applicants respectfully believe that this rejection is inadequate to establish a prima facie case of anticipation because the single cited reference does not disclose all of the essential elements of the claims arranged as required by the claims and in as complete detail as in the claims.

First, with regard to the limitation of wirelessly communicating the reference to another device to initiate a print by reference of the print content, the Aoki reference does not disclose this limitation for similar reasons as explained heretofore with reference to claim 3.

Second, with regard to the limitation of the reference specifying billing information, the Office states that these features are disclosed by paragraphs [0111]-[0112] of the Aoki reference. Applicants respectfully disagree, in that the reference of the Aoki reference does not specify billing information. Fig. 6 illustrates the process of the data output control terminal 300:

“In step S200, it is determined whether or not the data print request has been received from the portable terminal 100. If it is determined that the data print request has been received

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(Yes), the processes move to step S202, in which data included in the received data print request (including at least the portable-terminal-position data and the print target storage location data) is obtained. ... In step S218, it is determined whether or not a data print execution request has been received from the portable terminal 100. If it is determined that the data print request has been received (Yes), the processes move to step S220, in which authentication data is received from the portable terminal 100. The processes then move to step S222, in which authentication processes are executed, based on the received authentication data, in order to determine whether or not the user of the portable terminal 100 is a legitimate user of the print service provided by the data output control terminal 300. ... Next, in step S224, ... if the user is determined as a legitimate user (Yes), the processes move to step S226, in which the data which can be printed by the determined printing apparatus PR is transmitted to the printing apparatus PR. The processes then move to step S228, in which billing processes are executed in which billing is executed in accordance with the result of usage by the portable terminal 100 of the print service provided by the data output control terminal 300. Next, the processes move to step S230, in which a billing message, which indicates the service charge calculated in the billing processes of step S228 is transmitted to the portable terminal 100.” (para. [0098]-[0106]; emphasis added)

Thus it can be seen that the reference to print content stored at a location indicated by the reference (i.e. the data print request received at step S200) does not specify billing information. Rather, billing information, which is associated with the user of portable terminal 100, is determined from the authentication data that is received at step S220, separate from and subsequent to the data print request received at step S200.

The novel features of the present invention are not anticipated by the Aoki reference in that the essential element, arranged as required by the claim and recited in as complete detail as in the claim, is absent from the reference. Therefore, the rejection is improper at least for that reason and should be withdrawn.

The rejection of independent claim 6 is respectfully traversed at least because the single cited reference does not disclose all of the essential elements of the claims arranged as required by the claims and in as complete detail as in the claims. In this regard, claim 6 recites:

“6. (Previously presented) A print by reference method executable by a portable wireless device, the method comprising the steps of:
obtaining a reference to print content stored at a location indicated by the reference; and
wirelessly communicating the reference to another device to initiate a print by reference

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of the print content.

wherein the reference specifies a number of copies of the print content to be printed by a print device.” (emphasis added)

Applicants respectfully believe that this rejection is inadequate to establish a prima facie case of anticipation because the single cited reference does not disclose all of the essential elements of the claims arranged as required by the claims and in as complete detail as in the claims.

First, with regard to the limitation of wirelessly communicating the reference to another device to initiate a print by reference of the print content, the Aoki reference does not disclose this limitation for similar reasons as explained heretofore with reference to claim 3.

Second, with regard to the limitation of the reference specifying a number of copies of the print content to be printed by a print device, the Office states that this feature is disclosed by paragraph [0143] of the Aoki reference. Applicants respectfully disagree, in that the reference to print content of the Aoki reference does not specify the number of copies of the print content to be printed by a print device:

“The processes then move to step S104, in which various information associated with printing is input via the key panel 40. As the various information associated with printing, the user inputs, for example, a URL which uniquely identifies the location of the WWW server DS on the Internet, which stores the print data to be printed, a desired service area which is the approximate location where the service of output data is desired, print specifications of the printing apparatus PR, such as the size of paper, a designation of color/monochrome, printing resolution, and printing speed, a data format of the print data to be printed, and when a printing apparatus PR is to be directly specified, a printing apparatus ID for identifying the printing apparatus PR. All of these input items are not necessarily required, but are selectively input according to user requirements.” (para. [0078])

Nowhere among the above items is found the specification of a number of copies of the print content to be printed.

Furthermore, paragraph [0143] cited by the Office is not directed to the contents of the reference to print content. Rather, it describes a calculation by data output control terminal 300 that can define a service charge for the user of portable terminal 100 without the printing

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apparatus counting the number of prints.

The novel features of the present invention are not anticipated by the Aoki reference in that at least one essential element, arranged as required by the claim and recited in as complete detail as in the claim, is absent from the reference. Therefore, the rejection is improper at least for that reason and should be withdrawn.

The rejection of independent claim 15 is respectfully traversed at least because the single cited reference does not disclose all of the essential elements of the claims arranged as required by the claims and in as complete detail as in the claims. In this regard, claim 15 recites:

"15. (Previously presented) A print by reference method executable by a portable wireless device, the method comprising the steps of:
obtaining a reference to print content stored at a location indicated by the reference;
wirelessly communicating the reference to another device to initiate a print by reference of the print content; and
communicating a discovery signal that comprises a request for information about a capability of the another device." (emphasis added)

Applicants respectfully believe that this rejection is inadequate to establish a prima facie case of anticipation because the single cited reference does not disclose all of the essential elements of the claims arranged as required by the claims and in as complete detail as in the claims.

First, with regard to the limitation of wirelessly communicating the reference to another device to initiate a print by reference of the print content, the Aoki reference does not disclose this limitation for similar reasons as explained heretofore with reference to claim 3.

Second, with regard to the limitation of communicating a discovery signal that comprises a request for information about a capability of another device, the Office states that this feature is disclosed by paragraphs [0134], [0136], and [0137] of the Aoki reference. Applicants respectfully disagree.

Claim 15 recites, on its face, that the reference to print content and the discovery signal are different elements. The Office states that the discovery signal is the print ID request (printing

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apparatus ID, para. [0137]) of the Aoki reference (Office Action, p.6). However, the printing apparatus ID is not a separate element from the data print request (i.e., reference to print content), but rather part of the data print request (para. [0078]).

The novel features of the present invention are not anticipated by the Aoki reference in that at least one essential element, arranged as required by the claim and recited in as complete detail as in the claim, is absent from the reference. Therefore, the rejection is improper at least for that reason and should be withdrawn.

Rejection Under 35USC §103

Claims 32-33 have been rejected under 35 USC §103 (a), as being unpatentable over U.S. patent application publication 2002/0032652 to Aoki et al. ("Aoki"). Applicants respectfully traverse the rejection and request reconsideration.

As to a rejection under §103(a), the U.S. Patent and Trademark Office ("USPTO") has the burden under §103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. See *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

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The rejection of independent claim 32 is respectfully traversed for at least the following reasons. Claim 32 recites:

“32. (Original) A print by reference method executable by a portable wireless device, the method comprising the steps of:

obtaining a reference to print content stored at an Internet location indicated by the reference;

including the reference in a communication signal formatted according to a Bluetooth communication protocol; and

wirelessly communicating the communication signal to a print device thereby causing the print device to use the reference to retrieve the print content from the Internet and to print the print content.” (emphasis added)

The Office has not established a *prima facie* case of obviousness at least because the applied references do not teach or suggest all of Applicants’ claim limitations.

With regard to the limitation of wirelessly communicating the communication signal to a print device thereby causing the print device to use the reference to print the print content, the Aoki reference does not disclose this limitation for similar reasons as explained heretofore with reference to claim 3.

Therefore, for the reasons discussed herein, the applied references do not teach or suggest all of Applicants’ claim limitations.

The rejection of independent claim 33 is respectfully traversed for at least the following reasons. Claim 33 recites:

“33. (Original) A print by reference method executable by a portable wireless device, the method comprising the steps of:

obtaining a reference to print content stored at an Internet location indicated by the reference;

including the reference in a communication signal formatted according to a Bluetooth communication protocol; and

wirelessly communicating the communication signal to a print service thereby causing the print service to use the reference to retrieve the print content from the Internet, to format the print content for printing, and to pass the print content to a print device for printing.” (emphasis added)

The Office has not established a *prima facie* case of obviousness at least because the

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applied references do not teach or suggest all of Applicants' claim limitations.

With regard to the limitation of wirelessly communicating the communication signal to a print device thereby causing the print service to use the reference to pass the print content to a print device for printing, the Aoki reference does not disclose this limitation for similar reasons as explained heretofore with reference to claim 3.

Therefore, for the reasons discussed herein, the applied references do not teach or suggest all of Applicants' claim limitations.

Conclusion

Attorney for Applicants has reviewed each one of the cited references made of record and not relied upon, and believes that the claims presently on file in the subject application patentably distinguish thereover, either taken alone or in combination with one another.

Therefore, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication with Applicant's attorney would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned Robert C. Sismilich, Esq. at the below-listed telephone number.